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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,362	10/05/1999	Manfred Jendick	PM256642	9601

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EXAMINER

HUYNH, LOUIS K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 04/23/2004

43

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,362

Applicant(s)

JENDICK, MANFRED

Examiner

Louis K. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44,57,61,63,75,76,80,81,90,91,93-96 and 98-112 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 44,57,61,63,75,76,80,81,90,91,93-96 and 98-112 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 05 October 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 111 is objected to because of the following informalities:

“tracebilty” (line 2) should be changed to: --tracebility--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 44, 61, 63, 75, 81, 90, 91, 93-96, 98, 99, 103-105, 107, 109 and 111 are rejected under 35 U.S.C. 102(e) as being anticipated by Stasiuk (US 6,105,806).

With respect to Claims 44, 91 and 93, Stasiuk discloses a method for manufacturing articles to be included in cans including the steps of: intermittently feeding a metal strip (tab stock 90) having an upper surface and a lower surface into an article forming unit (75); and

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providing an engraving using a laser unit (col. 9, lines 21-51). Regarding the limitation of the metal strip being engraved in an immobilized condition, Stasiuk teaches that the metal strip (tab stock 90) must be correctly positioned then being engraved by the laser (col. 9, lines 31-39) which implies that the metal strip is engraved while in an immobilized condition. Note that the forming unit (75) of Stasiuk is a high speed forming unit; therefore, the metal strip is intermittently fed in periods of rapid movement.

With respect to Claims 61 and 81, Stasiuk discloses an article to be included in cans to be the pull tab (124) attached to a can end (120).

With respect to Claims 63, 90 and 95, Stasiuk discloses an apparatus for manufacturing articles to be included in cans including: a supply of a metal strip (tab stock 90); an article forming unit (70); a strip feeder for feeding the metal strip (90) through the forming unit (75); at least one laser unit for providing decorative engraving on the metal strip (col. 8, line 39-col. 9, line 17); and an inherent control unit in communication with the at least one laser unit to control the at least one laser unit for providing engraving on the metal strip. Regarding the functional limitation of the control unit controls the laser unit so that the laser engravings are provided when the strip is in an immobilized condition, Stasiuk teaches that the metal strip (tab stock 90) must be correctly positioned then being engraved by the laser (col. 9, lines 31-39) which implies that the control unit controls the at least one laser unit so that the metal strip is engraved while in an immobilized condition. Note that the forming unit (75) of Stasiuk is a high speed forming unit; therefore, the metal strip is intermittently fed in periods of rapid movement.

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With respect to Claim 75, Stasiuk discloses in FIG. 7 a decorating area (100) for laser engraving the metal strip (90) being arranged adjacent to the forming unit (75) without interfering the operation of the forming unit.

With respect to Claims 94 and 96, Stasiuk teaches that the engraving on the metal strip can be a picture, trademarks, icon, character, prize redemption, or other symbolic item (col. 3, lines 34-47).

With respect to Claim 98, the metal strip (90) does have a thickness defined between the upper surface and the lower surface. Regarding the limitation of the engravings extend into a metal portion of the metal strip to a depth that is within the thickness of the metal strip, the high powered laser unit discloses by Stasiuk, such as 200 watt Nd:YAG laser or 600 watt CO2 laser (col. 9, lines 13-17), is known to be capable of marking into the metal portion of a metal strip to a desired depth within the thickness of the metal strip.

With respect to Claims 99, Stasiuk discloses in FIG. 1 a can (10) having a decorative pull tab (40) and the tab (40) is decorated with laser engraving (col. 8, line 58-col. 9, line 17). Note that the patentability of a product does not depend on its method of production.

With respect to Claim 103, Stasiuk teaches that the decorating area (100) for providing laser engravings onto the metal strip can be arranged in any suitable manner including the arrangement of FIG. 7 wherein the strip is engraved in the decorating area (100) before the strip is fed into the forming unit (75) (col. 7, lines 49-58).

With respect to Claim 104, Stasiuk teaches the metal strip can be a coated metal strip (col. 7, lines 34-40), and the laser engraving extends through the coating and into the metal surface of the metal strip (FIG. 12).

With respect to Claims 105 and 109, Stasiuk teaches the metal strip can be a coated metal strip (col. 7, lines 34-40), and the laser engraving extends through the coating (FIG. 12).

With respect to Claims 107 and 111, Stasiuk discloses in FIG. 10 that a can end (120) can be formed and provided with a laser engraving (BRAND EQUITY logo) for traceability using the method and apparatus disclosed in the Stasiuk reference (col. 9, line 60-col. 10, line 20).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 80, 100-102, 106, 108, 110 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stasiuk (US 6,105,806).

With respect to Claim 80, it would have been obvious to a person with an ordinary skill in the art to switch off the laser unit when engravings are not needed.

With respect to Claims 100, 106, 108, 110 and 112, the method and apparatus of Stasiuk meets all of applicant's claimed subject matter but lacks the specific teaching of the engravings extending a finite depth into the metal strip. However, Stasiuk discloses in the summary of his invention that a decorative tab having uncoated surface is provided with a permanent tab decorative using an optical device (col. 3, lines 16-21). Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the method and apparatus of Stasiuk by having provided laser engravings that extends a finite

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depth into the metal strip in order to form permanent tab decorations, which would include prize redemptions.

With respect to claims 101 and 102, Stasiuk teaches that the exact setting of the laser unit is obvious to a skilled person in the art as a matter of engineering designed choice since the laser can be controlled to effect the speed of production (col. 9, lines 4-13); therefore, it does not patentably distinguish the claimed inventions over the applied prior art. Thus, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have provided the decorative tab with at least four characters of the size that can be formed in less than 60 milliseconds.

7. Claims 57 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stasiuk (US 6,105,806) in view of JP'99 (JP 7-53099).

The apparatus and method of Stasiuk for engraving metal strip meets all of applicant's claimed subject matter but lacks the specific teaching of the guiding elements that guide the metal strip past the laser unit.

However, JP'99 disclose a guiding system for a strip of material wherein the strip of material (2) is guided between guiding elements (21 and 22) and a cover (16) having openings (20) for print heads (4) to print on the strip of material, wherein one of the guide elements (22) is displaceable and is biased toward the strip of material (2) against the other guide element (21) for keeping the strip of material from fluctuating upward and/or sideways.

Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the apparatus and method of Stasiuk by having

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provide a guiding system for guiding the metal strip to laser unit, as taught by JP'99, in order to keep the metal strip from fluctuating upward and/or sideways since laser engraving required high precision placement of the work piece.

Response to Amendment

8. The Affidavit filed on February 12, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Stasiuk reference (US 6,105,806).

9. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Stasiuk reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The photocopy and the sketch provided are insufficient to support the claimed invention, specifically, they do not show and/or describe the limitation of providing the metal strip with laser engravings from a laser when the metal strip is in an immobilized condition which applicant regards as an important feature of his invention.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

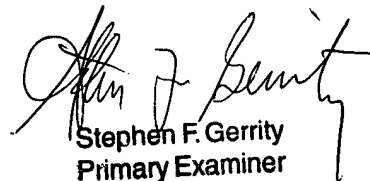
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (703) 306-5694.

The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH
April 20, 2004


Stephen F. Gerrity
Primary Examiner